

REMARKS

The Office Action of November 22, 2006 has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. Applicants appreciate the Examiner's careful examination of the application.

I. STATUS OF THE CLAIMS

Claims 1, 3-30 are pending in the application.

Independent claims 1, 6, 11, and 22 have been amended to further define the invention. No new matter has been added.

Dependent claims 3-5, 7, 10, 12, 15-21, 23, 24, and 27 have been amended to clarify and make consistent their terminology. Claims 19-21 and 27 have been amended to further define the invention. No new matter has been added.

Dependent claim 2 has been cancelled without prejudice.

Dependent claims 28-30 have been added. Support for dependent claim 28 can be found in Applicants' Specification, paragraph 21. Support for dependent claim 29 can be found in Applicants' Specification, paragraphs 28-31. Support for dependent claim 30 can be found in Applicants' Specification, paragraphs 32-35. No new matter has been added.

Claims 5-21, 23, 24, and 27 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-3, 5-15, 18, and 22-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ryan, Jr. et al., United States Patent # 7,071,437, issued on July 4, 2006, published on July 3, 2003, filed on December 31, 2001 (Ryan). Applicants respectfully point out that Ryan was

published within a year of Applicants' filing date, October 30, 2003. Applicants reserve the right to swear behind Ryan.

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Lopez, United States Patent Application # 2002/029,202, published on March 7, 2002, filed on December 13, 2000 (Lopez).

Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Bloomfield, United States Patent # 6,025,931, issued February 15, 2000 (Bloomfield).

Claims 19-21 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Kagehiro et al., United States Patent # 6,246,794, issued June 12, 2001 (Kagehiro).

The drawings were objected to as failing to comply with 37 C.F.R. § 1.84(p)(5). Applicants herein submit corrected drawings for Figures 3, 6, and 7.

The specification was objected to because of several informalities. Applicants herein submit a response to the objections.

II. OBJECTIONS TO THE DRAWINGS

On page 2, in paragraph 1, the Office Action states that the drawings are objected to under 37 C.F.R. § 1.84(p)(5) because they do not include reference numbers 160 and 260. Applicants herein submit Replacement Sheets for Figures 6 and 7, which now contain reference numbers 160 and 260 respectively. No new matter has been added.

On page 2, in paragraph 2, the Office Action states that the drawings are objected to as failing to comply with 37 C.F.R. § 1.84(p)(5) because they include reference numbers that are not referred to in the specification: reference numbers 30 and 65 in Figure 1, reference numbers 8, 12, and 15 in Figure 3, and reference number 340 in Figure 5. Applicants have amended the specification,

paragraphs 21 (reference numbers 8, 12, 15, 30 and 65) and 44 (reference number 340), to include the omitted reference numbers. No new matter has been added.

On page 2, in paragraph 3, the Office Action states that the drawings are objected to because Figure 3 should have reference numbers for each block to provide consistency. Applicants herein submit a Replacement Sheet for Figure 3, which now contains additional reference numbers 22, 24, 26, 28, 32, 34, and 60, which are also referred to in the specification in amended paragraph 27 (reference number 26), paragraph 28 (reference numbers 28 and 34), and paragraph 39 (reference numbers 22, 24, and 32). Reference number 60 had previously been referenced in paragraph 21, and thus no amendments to the specification to accommodate reference number 60 are required. No new matter has been added.

III. OBJECTIONS TO THE SPECIFICATION

On page 3, in paragraph 4, the Office Action states that the specification is objected to because of informalities on pages 1 (lines 1 and 2), 15 (Table 1), 21 (paragraph 3), 24 (Table 2), 25 (Table 2), 26, (table 2), and 28 (paragraph 44).

Applicants respectfully point out that pages 1, 15, 24, 25, and 26 do not contain errors on Applicants' as-filed specification. See the attached pages. With respect to page 2, top line, there is no new paragraph. Paragraph [0004] begins on page 1 as shown in the attachment. Applicants have amended paragraphs 39 (page 21, paragraph 3) and 44 (page 28) to correct reference number and figure number inaccuracies. No new matter has been added.

IV. REJECTIONS UNDER 35 U.S.C. § 112

On pages 4-6, in paragraphs 5-6, the Office Action states that claims 5-21, 23, 24, and 27 are rejected under 35 U.S.C. § 112, second paragraph.

With respect to claims 5, 10, 15, and 24, the Office Action states that the limitation “wherein the at least one image characteristic is selected” renders the claim indefinite because it is unclear which image characteristic is being mentioned or referred to. The Office Action has interpreted this clause as follows: “wherein the at least one image characteristic for the image of the mail piece and for one of the predetermined profiles is selected”. Applicants have amended dependent claims 5, 10, 15, and 24 to clarify the terminology. No new matter has been added.

With respect to claims 6, 11, and 16 and their dependent claims, the Office Action states that the limitation “if the at least one image characteristic present in the retrieved data substantially matches the at least one image characteristic from the retrieved data” renders these claims indefinite because a comparison between two same components is being made. Applicants have amended claims 6, 11, and 16 to clarify the terminology. No new matter has been added.

With respect to claim 18, the Office Action states that the limitation “a fourth memory” renders this claim indefinite because a third memory is not mentioned in its preceding claims. Applicants have amended claim 18 to clarify the terminology. No new matter has been added.

With respect to claims 19, 20, 21, and 27, the Office Action states that the limitation “wherein the at least one image characteristic comprises” renders these claims indefinite because it is unclear which image characteristic is being mentioned or referred to. Applicants have amended claims 19-21 and 27 to clarify the terminology. No new matter has been added.

With respect to claim 23, the Office Action states that the limitations “retrieving the data”, “profiles from the database”, and “identified by the action identifier” have insufficient antecedent basis. Applicants have amended claim 23 to correct the antecedent basis. No new matter has been added.

V. REJECTIONS UNDER 35 U.S.C. § 102

On pages 6-12, in paragraphs 7-8, the Office Action states that claims 1-3, 5-15, 18, and 22-26 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Ryan.

Applicant respectfully points out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims.

Independent claims 1 and 22 have been amended to incorporate the limitations stated in dependent claims 2 and 23 respectively. No new matter has been added.

It is submitted that amended independent claims 1 and 22 are not anticipated by Ryan because Ryan does not teach Applicants' claimed repeating steps (c) through (e) for another one of the plurality of predetermined profiles, if the at least one profile image characteristic does not substantially match the at least one mail piece image characteristic. More specifically, Ryan does not teach Applicants' claimed invention because (1) Ryan does not disclose a plurality of predetermined profiles, and (2) Ryan's analysis with respect to Ryan's suspect database terminates after a single comparison because there is no plurality of predetermined profiles with which Ryan can perform successive comparisons. Ryan cannot make subsequent comparisons to the suspect database because the suspect database contains Ryan's stated criteria (Ryan, col. 5, lines 20-65) and the comparison software labels a mail piece suspect if the mail piece satisfies a certain percentage of those criteria (Ryan, col. 12, lines 18-24). Applicants, on the contrary, claim repeating the comparison between mail piece image characteristics and profile image characteristics for another of Applicants' claimed predetermined profiles if the mail piece and profile image characteristics don't match. Ryan teaches neither multiple profiles nor multiple comparisons for the same mail piece.

Dependent claim 2 has been cancelled without prejudice.

It is submitted that dependent claims 3 and 5 are patentable at least by virtue of their dependence upon amended independent claim 1.

It is submitted that independent claims 6 and 11 are not anticipated by Ryan because Ryan does not teach Applicants' claimed data for a predetermined profile comprising an action identifier. Ryan does not teach Applicants' claimed action identifier (see Applicants' Specification, paragraph 24, for an example of a profile and an action associated with the profile, and paragraph 46 for a description of the contents of a profile) because Ryan simply states a list of suspect criteria (Ryan,

col. 5, lines 20-65), and then later refers to these criteria as a suspect database (Ryan, col. 12, line 15), but provides no other details about the suspect database. Further, Ryan provides no reason for Applicants' claimed action identifier because Ryan states a single action when a suspect mail piece is found: divert the suspect mail piece to a diverter collection module (Ryan, FIG. 9c, steps 210 and 212).

It is submitted that dependent claims 7 and 12 are not anticipated by Ryan for the same reasons stated with respect to amended independent claims 1 and 22. Ryan does not teach Applicants' claimed another predetermined profile, nor does Ryan teach Applicants' claimed computer readable code that causes a processor to compare the mail piece characteristics to data from the another predetermined profile because Ryan has a single list of criteria which are compared against a single mail piece, and the mail piece is either diverted or not. In Applicants' system, readable code performs multiple comparisons against a single mail piece, which Ryan does not teach.

It is submitted that dependent claims 8, 9, 10, 13, 14, 15, 18, 24, 25, 26 are patentable at least by virtue of their selective direct or indirect dependence upon amended independent claims 6, 11, and 22.

It is submitted that dependent claim 23 is not anticipated by Ryan for the same reasons as stated with respect to independent claims 6 and 11.

Since Ryan does not teach each and every element of Applicants' amended independent claims 1, 6, 11, and 22 and claims 3-5, 7-10, 12-21, and 23-28 which depend selectively therefrom, Applicants' amended independent claims 1, 6, 11, and 22 and dependent claims 3-5, 7-10, 12-21, and 23-28, are not anticipated by Ryan, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Further, it is submitted that amended independent claims 1, 6, 11, and 22 and dependent claims 3-5, 7-10, 12-21, and 23-28 are not made obvious by Ryan under 35 U.S.C. § 103. Applicants assert that amended independent claims 1, 6, 11, and 22 and dependent claims 3-5, 7-10, 12-21, and 23-28, are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 102(e) with regards to amended independent claims 1, 6, 11, and 22 and claims 3-5, 7-10, 12-21, and 23-28, for the reasons set forth above.

VI. REJECTIONS UNDER 35 U.S.C. § 103

On pages 12-13, in paragraphs 9-10, the Office Action states that dependent claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Lopez.

It is submitted that amended dependent claim 4 is not obvious in view of Ryan and Lopez because neither Ryan nor Lopez nor their combination discloses or suggests Applicants' claimed step of repeating steps (c) through (e) for another one of the plurality of predetermined profiles, if the at least one profile image characteristic does not substantially match the at least one mail piece image characteristic. As stated previously with respect to independent claims 1 and 22, Ryan lacks this step. Lopez does not make up Ryan's deficiency because Lopez performs certain steps on-line, and a different set of steps off-line, neither of which include comparing a particular mail piece against multiple profiles.

On pages 13-14, in paragraph 11, the Office Action states that dependent claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Bloomfield.

It is submitted that dependent claims 16 and 17 are not obvious in view of Ryan and Bloomfield because neither Ryan nor Bloomfield nor their combination discloses or suggests Applicants' claimed remote server having computer readable code that identifies the mail piece as requiring the action identified by the action identifier from the retrieved data. Ryan does not disclose Applicants' claimed remote server having computer readable code that includes an action identified by the action identifier from the retrieved data for the reasons stated previously with respect to independent claims 6 and 11. Bloomfield does not make up for Ryan's deficiency because Bloomfield simply forwards e-mail (Bloomfield, col. 7, lines 49-59) without reference to any sort of action identifier in a profile database.

On pages 15-16, in paragraph 12, the Office Action states that dependent claims 19-21 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Kagehiro.

Dependent claims 19-21 and 27 have been amended to further define the invention. Support for the amendment can be found in Applicants' Specification, paragraph 44.

It is submitted that amended dependent claims 19-21 and 27 are not obvious in view of Ryan and Kagehiro. Neither Ryan nor Kagehiro nor their combination discloses or suggests Applicants' claimed one of the predetermined profiles comprises at least one distinguishing handwriting

characteristic for handwriting penned by one individual. Ryan does not disclose or suggest Applicants' claimed at least one distinguishing characteristic for handwriting penned by one individual because Ryan's criteria (Ryan, col. 5, lines 21-65) are general and apply to all individuals, but not Applicants' claimed handwriting penned by one individual. Kagehiro does not make up Ryan's deficiency because Kagehiro states a system in which individual characters are disambiguated, but there is no connection between an individual and the characters stated in Kagehiro that would, combined with Ryan, make obvious Applicants' claimed at least one distinguishing handwriting characteristic for handwriting penned by one individual.

Since none of Ryan, Lopez, Bloomfield, or Kagehiro, either individually or in combination, teach or suggest each and every element of Applicants' dependent claims 4, 16, 17, 19-21, or 27, Applicants' dependent claims 4, 16, 17, 19-21, or 27, are not made obvious by Ryan, Lopez, Bloomfield, and Kagehiro, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claims 4, 16, 17, 19-21, or 27, are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claims 4, 16, 17, 19-21, or 27, for the reasons set forth above.

VII. CONCLUSION


Amended independent claims 1, 6, 11, and 22 are believed to be in condition for allowance for the reasons provided herein. It is submitted that dependent claims 3-5, 7-10, 12-21, and 23-28, are also allowable for the reasons presented above, and further because they depend upon independent claims which are believed to be in condition for allowance, and are therefore also believed to be in condition for allowance.

One dependent claim, claim 2, has been cancelled, and three dependent claims, claims 28-30, have been added. The Commissioner for Patents is authorized to charge additional fees, in particular the large entity fee of \$100 for two additional dependent claims over twenty, or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-194.

The following information is presented in the event that a call may be deemed desirable by the Examiner: Kathleen Chapman (617) 345-3210

Respectfully submitted,
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